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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/121,596 07/24/98 MAYAUD

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EXAMINER

020277
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

TM02/1015

RIMELL, C
ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

T.R

Office Action Summary

Application No.

09/121,596

Applicant(s)

MAYAUD, CHRISTIAN

Examiner

Sam Rimell

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2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70, 72-92 and 94-102 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 70, 72-92, 94-102 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

SAM RIMELL
PRIMARY EXAMINER
2166

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 70, 72-83, 91-92, 94-99, and 101-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. ('599).

Schrier et al. discloses a system having a user computer (112) having graphical user interfaces (figures 2-22) which permit the capture of prescription information and which are ultimately provided to create a prescription (col. 4 lines 43-45). The computer is connected to a network system which provides: (1) information about a patient's medical history and prescription history (col. 6 lines 5-11); (2) information about pharmaceuticals arranged by medical conditions (FIG. 3); and (3) information about the properties of pharmaceuticals (Figs 6, 7 and 10-22). The computer (112) is connected to a network of computers as part of a hospital or other type of clinical setting (col. 5 lines 18-24). No patentable weight is attributable to who runs or operates the other computers that the computer (112) communicates with, since this has no bearing on the physical structure of the system.

The user computer (112) can gather information or transmit information to the other computers in the network (col. 5, lines 18-24).

Information about patient histories, drug information and costs can be gathered from the other computers in the network (col. 5, lines 18-24).

The system permits a prescription to be sent electronically to a pharmacy (col. 14, line 67).

The information about the pharmaceuticals can be recorded in the order in which they are prescribed to a user (col. 15 line 6) or in alphabetical order (232 in FIG. 3).

The information about the pharmaceuticals can be recorded in order of the body system treated or drug category (234 in FIG. 3 illustrates drug categories, but certain categories are specific to treatment of certain body systems, for example, antifungals are specifically used for treatment of the skin and anti-depressants are specifically used for the central nervous system).

The graphical user interface of the user computer (112) can also suggest alternative medications with alternative costs (FIG.9).

“Discarding” a current version of a patient medical history or any other stored file information and replacing it with an updated medical history or file is inherent in a computer system with a random access memory. An updated file can be saved by replacing the updated file with the original file, without saving the original file.

The system of Schrier et al. also permits a patient medical history to include the identification of one or more prescriptions (col. 6, line 8 “concomitant drugs”) and an identification of the individual prescribing the drugs (col. 21, line 42 “Health ID”).

The graphical user interface of the user computer (112) in Schrier et al. also provides suggested dosages (FIG. 5).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84-90 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al. ('599) in view of Ballantyne et al. ('821).

Ballantyne et al. discloses the usage of personal digital assistants (10) as a user computer in a telemedicine environment. It would have been obvious to one of ordinary skill in the art to substitute a personal digital assistant for the user computer (112) in Schrier et al. so as to allow the user the advantage of mobility, as taught by Ballantyne et al.

Remarks

Claims 70, 72-92 and 94-102 had been rejected under 35 USC 112, second paragraph as being indefinite. The last three lines of claims 70 and 99 were found in particular to be indefinite, and Examiner suggested the adoption of Markush type limitations to resolve this basis of rejection. Although standard Markush type limitations have not been adopted, Examiner believes that the claims as amended are now sufficiently clear to meet the statutory requirements of 35 USC 112, and the rejection has been withdrawn.

Claims 85, 91, 94 and 100-102 had been rejected under 35 USC 112 second paragraph as being indefinite. Applicant's amendments have overcome this grounds of rejection, and the rejection has been withdrawn.

Claims 70, 72-83, 91-92, 94-99 and 101-102 have been rejected under 35 USC 102(e) as being anticipated by Schrier et al. ('599).

With respect to claim 70, applicant argues that Schrier et al. does not teach any of the alternatively business organizations recited in this claim. For example, applicant argues that Schrier et al. does not teach the concept communicating with computers owned by an HMO, and insurance company, a laboratory, a physician practice etc. However, Examiner maintains that no

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patentable weight can be attributed to the type business entity that owns the computers. When a claimed method is a method of using a computer system, the actual party that legally owns a computer in the system has no bearing on the method itself. The series of steps involving the creation and movement of data remains the same regardless of what legal entity actually owns the computers that create and move that data. Accordingly, no patentable weight is attributable to the recitation of legal entities that own the computers used in the claim method.

Even assuming, *arguendo*, that patentable weight could be attributed to the legal ownership of the computers in a network, some of the alternatives for legal representatives are taught by Schrier et al. The Schrier et al. reference teaches that the user computer (112) is part of a hospital information system (col. 5, line 19) and thus would inherently communicate with physicians offices, pharmacies and laboratories. In order to meet the requirements of claim 70, only one of these alternatives need to be met.

Applicant argues that claim 99 has amended to contain similar limitations to that of claim 70 and thus equally distinguishes from Schrier et al. Applicant argues that claim 99 has been converted to a method claim, but Examiner finds no such amendment. Claim 99 remains rejected for the same reason as that of claim 70.

Applicant argues that Schrier et al. does not teach the concepts of compiling a patient record by interrogating remotely located databases expected to contain information about a patient, as recited in claim 91. However, this argument is not correct. Schrier et al. explicitly teaches that the user computer (112) is part of a network and can retrieve data from other parts of the network to assemble information about patients (col. 5, lines 18-24).

Applicant argues that Schrier et al. does not disclose the concept of capturing information about individual prescriber activity, as specified in claim 94. As understood, the “prescriber activity” refers to the history of prescriptions written by a physician. Schrier et al. does in fact disclose such a feature, assuming the interpretation of “prescriber activity” is correct. Column 15, lines 5-6 of Schrier et al. explicitly state that the date, time, and ordering physician for each prescription are stored.

With respect to claim 101, applicant argues that Schrier et al. does not teach the concept of interrogating offsite databases, or databases expected to contain patient information. This is not correct. Schrier et al. et al. explicitly teaches the use of a computer (112) to retrieve data from other computers in a network, where the data includes information about patients (col. 5, lines 18-24).

With respect to claim 102, applicant argues that Schrier et al. does not disclose the concept of capturing information about individual prescriber activity. Examiner maintains that Schrier et al. does in fact contain such a teaching. See examiners rebuttal with respect to claim 94 discussed above.

With respect to claims 84-90 and 100, applicant argues that the device of Ballantyne et al. is not a personal digital assistant, but is rather a “personal data assistant” which is allegedly distinct from the “personal digital assistant” claimed. Examiner does not believe that there is any distinction between these structures. Both the “personal digital assistant” and “personal data assistant” are portable computer systems with processors and memories, and which accept pen based input.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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